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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,530	04/14/1999	MARKUS PLACHO	P99.0340	2432
7590	04/28/2004		EXAMINER	
Kevin R Spivak Morrison & Foerster LLP 2000 Pennsylvania Avenue NW Washington, DC 20006-1888			GARY, ERIKA A	
		ART UNIT	PAPER NUMBER	19
		2681		
DATE MAILED: 04/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/284,530	PLACHO ET AL.
	Examiner	Art Unit
	Erika A. Gary	2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on February 12, 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art cited in the previous Office Action, Beeson, Jr. et al., US Patent Number 5,396,543 (hereinafter Beeson), in view of applicant's submission or prior art, Bjorndahl, P, "CME 20 – A Total Solution for GSM Networks" (hereinafter Bjorndahl).

Regarding claim 1, Beeson discloses a method for controlling switching-oriented actions in a mobile radio telephone system having at least one radio-oriented sub-system with base station controllers and base stations for radio connections from and to mobile stations of mobile subscribers, having a switching-oriented sub-system with subscriber data bases and mobile switching centers for line-switched connections and having an operation and maintenance sub-system, the operation and maintenance sub-system having at least one operation and maintenance center for administration and control of devices provided in the radio-oriented sub-system and in the switching-oriented sub-system, comprising the steps of: establishing respective mobile radio telephone-specific data for defining conditions for a subscriber-contended control of actions in a mobile switching center, the data being established subscriber-individually

for at least one mobile subscriber and respectively evaluating in the mobile switching center, given one of an incoming call, an outgoing call or a message transmission at least one of call-related data and subscriber specific data with respect to the conditions and, given a satisfied condition, controlling at least one action subscriber-dependent [fig. 2; col. 4: line 66 – col. 5: line 25; col. 11: line 26 – col. 12: line 31].

What Beeson does not specifically disclose is that for the respective mobile radio telephone-specific data for defining conditions for a subscriber-contended control of actions in a mobile switching center, the data is established subscriber-individually for at least one mobile subscriber via the operation and maintenance sub-system. However, Bjorndahl teaches this limitation.

Bjorndahl discloses a method for controlling switching-oriented actions in a mobile radio telephone system having at least one radio-oriented sub-system with base station controllers and base stations for radio connections from and to mobile stations of mobile subscribers, having a switching-oriented sub-system with subscriber data bases and mobile switching centers for line-switched connections and having an operation and maintenance sub-system, the operation and maintenance sub-system having at least one operation and maintenance center for administration and control of devices provided in the radio-oriented sub-system and in the switching-oriented sub-system, comprising the steps of: establishing respective mobile radio telephone-specific data for defining conditions for a subscriber-contended control of actions in a mobile switching center, the data being established subscriber-individually for at least one mobile

subscriber via the operation and maintenance sub-system [figs. 5, 6; page 78, column 2, last paragraph – page 79, column 1, first paragraph].

Beeson and Bjorndahl are combinable because they are from the same field of endeavor, that is, controlling switching-oriented actions in a mobile radio telephone system. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Beeson to include Bjorndahl. The motivation for this modification as suggested by Bjorndahl would have been to perform tasks in the operation and maintenance sub-system to reduce administrative work load and enable management of rapid growth [page 78, column 2, last paragraph].

Regarding claim 2, Beeson discloses the conditions for the subscriber-dependent control of the actions are respectively defined by one of a single, call-related/subscriber-specific datum and an operation of a plurality of call-related/subscriber-specific data [col. 14: lines 59-63].

Regarding claim 3, it is inherent that the operation of the call-related/subscriber-specific data ensues via at least one of a logical AND operation and a logical OR operation.

Regarding claim 4, Beeson discloses given a plurality of satisfied conditions different actions are controlled subscriber-dependent [col. 4: line 66 – col. 5: line 25; col. 11: line 26 – col. 12: line 31].

Regarding claim 5, Beeson discloses given parallel existence of a plurality of satisfied conditions, the actions are provided with priority numbers with which is defined a sequence of actions to be controlled [col. 11: line 57 – col. 12: line 14].

Regarding claim 6, Beeson discloses given parallel existence of a plurality of satisfied conditions, blocking information is used to exclude a respective action of said actions from the control by another action of said actions [col. 4: lines 1-19].

Regarding claim 7, Beeson discloses the blocking information is entered into a table that is located in one of the mobile switching center and a subscriber data base of the mobile switching center [col. 4: lines 1-19].

Regarding claim 8, Beeson discloses one of a type of call or type of message transmission is evaluated as call-related data [col. 11: lines 10-20]

Regarding claim 9, Beeson discloses one of an international mobile subscriber identifier, a service class mark for triggering services of an intelligent network, a mobile subscriber category or supplementary services usable by the mobile subscriber is evaluated as subscriber-specific data [col. 9: lines 26-30].

Regarding claim 10, Beeson discloses given an outgoing call, a subscriber telephone number selected by the mobile subscriber or a numerical range of the selected subscriber telephone number is evaluated and, wherein the location telephone number or a numerical range of the location telephone number assigned in the mobile radio telephone system, respectively, is evaluated given the incoming call [col. 11: lines 10-20; col. 12: lines 21-25].

Regarding claim 11, Beeson discloses given an incoming call with call forwarding to a destination telephone number, the destination telephone number or a numerical range of the destination telephone number is evaluated [col. 19: lines 26-33].

Regarding claim 12, Beeson discloses one of blocking of a call, suppression of a call forwarding, and blocking of a message transmission is controlled subscriber-dependent as an action [col. 14: lines 59-63].

Regarding claim 13, Beeson discloses one of cleardown of a call and routing of a call to an announcement device are controlled subscriber-dependent as actions [col. 16: lines 3-37].

Regarding claim 14, Beeson discloses one of routing of a call connection to a specific destination and acquisition of call charges in a specific charge zone are controlled subscriber-dependent as actions [col. 12: lines 2-7].

Regarding claim 15, Beeson discloses routing of a call connection to a service control point of an intelligent network is controlled subscriber-dependent as an action and a service class mark is thereby set preceding a destination telephone number [col. 4: line 66 – col. 5: line 25; col. 11: line 26 – col. 12: line 31].

Regarding claim 16, Beeson discloses a telephone number modification by insertion of subscriber-individual information into one of a selected telephone number given an outgoing call, a location telephone number given an incoming call or a destination telephone number given an incoming call with call forwarding is controlled subscriber-dependent as an action [col. 22: lines 52-67].

Regarding claim 17, Beeson discloses an eavesdropping of a call connection or an authorization or, respectively, suppression of services/performance features are controlled subscriber-dependent as actions [col. 22: lines 38-51].

Regarding claim 18, it is inherent to convert an abbreviated code selected by the subscriber into a telephone number is controlled subscriber-dependent as an action.

Regarding claim 19, Beeson discloses a mobile radio telephone system for controlling switching-oriented actions comprising: at least one radio-oriented sub-system that has base station controllers and base stations for radio connections from and to mobile stations of mobile subscribers; a switching-oriented sub-system that has subscriber data bases and mobile switching centers for line-switched connections; an operation and maintenance sub-system having at least one operation and maintenance center for administration and control of devices provided in the radio-oriented sub-system and in the switching-oriented sub-system; mobile radio telephone-specific data defining conditions for a subscriber-dependent control of the actions, the mobile radio telephone specific data being subscriber-individually established for at least one mobile subscriber in the mobile switching center and the mobile switching center having a device that, given an incoming call or an outgoing call or given a message transmission, respectively evaluates at least one of call-related data and subscriber-specific data with reference to the conditions and, given a satisfied condition, controls at least one action subscriber-dependent [fig. 2; col. 4: line 66 – col. 5: line 25; col. 11: line 26 – col. 12: line 31].

What Beeson does not specifically disclose is that for the respective mobile radio telephone-specific data for defining conditions for a subscriber-contended control of actions in a mobile switching center, the data is established subscriber-individually for at

least one mobile subscriber via the operation and maintenance sub-system. However, Bjorndahl teaches this limitation.

Bjorndahl discloses a method for controlling switching-oriented actions in a mobile radio telephone system having at least one radio-oriented sub-system with base station controllers and base stations for radio connections from and to mobile stations of mobile subscribers, having a switching-oriented sub-system with subscriber data bases and mobile switching centers for line-switched connections and having an operation and maintenance sub-system, the operation and maintenance sub-system having at least one operation and maintenance center for administration and control of devices provided in the radio-oriented sub-system and in the switching-oriented sub-system, comprising the steps of: establishing respective mobile radio telephone-specific data for defining conditions for a subscriber-contended control of actions in a mobile switching center, the data being established subscriber-individually for at least one mobile subscriber via the operation and maintenance sub-system [figs. 5, 6; page 78, column 2, last paragraph – page 79, column 1, first paragraph].

Beeson and Bjorndahl are combinable because they are from the same field of endeavor, that is, controlling switching-oriented actions in a mobile radio telephone system. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Beeson to include Bjorndahl. The motivation for this modification as suggested by Bjorndahl would have been to perform tasks in the operation and maintenance sub-system to reduce administrative work load and enable management of rapid growth [page 78, column 2, last paragraph].

Response to Arguments

3. Applicant's arguments filed February 12, 2004 have been fully considered but they are not persuasive. Applicant argues that Bjorndahl does not teach establishing respective mobile radio telephone-specific data for defining conditions for a subscriber-contended control of actions in a mobile switching center, the data being established subscriber-individually for at least one mobile subscriber via the operation and maintenance sub-system. However, the Examiner respectfully disagrees. Bjorndahl teaches that the subscriber subscription parameters are stored in the HLR, but are entered by use of the OSS (operation and maintenance sub-system) [page 78, column 2, last paragraph – page 79, column 1, first paragraph]. It is well known in the art that different subscribers will have different subscriber-contended data as they will have different service preferences and different subscriber feature allocations. Further, as admitted by Applicant, Beeson teaches that data changes are "customer-initiated" [col. 12: line 2]. Hence, this is also subscriber-contended control of actions.

Applicant argues that a complete upload is performed for installing an HLR in Bjorndahl. Claims 1 and 19 recite "the data being established subscriber-individually". As this limitation is broadly claimed, the Examiner contends that the limitations are met by the combination of references.

Applicant also argues that the references are not combinable. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or

modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bjorndahl teaches that it is preferable to perform tasks in the operation and maintenance sub-system to reduce administrative work load and enable management of rapid growth [page 78, column 2, last paragraph]. Further, the Examiner contends that the references are from the same field of endeavor, that is, controlling switching-oriented actions in a mobile radio telephone system.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 703-308-0123. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, supervisor Marsha Banks-Harold can be reached on 703-305-4379. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750 or to the 2600 Customer Service Office 703-306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306 (for informal or draft communications, please label
“PROPOSED” or “DRAFT”).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, VA., Sixth Floor (Receptionist).

Erika Gary
Primary Examiner



ERIKA GARY
PATENT EXAMINER